

### **Remarks**

Claims 1, 4, 7-13, 15 and 18-20 are now pending in this application. In the May 28, 2004 Office Action, claims 1, 4, 7-13, 15 and 18-20 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,070,150 to Remington et al. (hereinafter "*Remington*") in view of U.S. Patent No. 5,724,521 to Dedrick (hereinafter "*Dedrick*"). Prior to discussing the reasons why the applicants believe that the claims currently pending in this application are allowable, a brief description of the present invention and the cited reference is presented.

### **Summary of the Invention**

The present invention provides a method and system for communicating with customers in which pre-selected non-billing information is combined with a customer's billing information to create a customized bill. The customized bill is arranged to include the non-billing information in the middle of the billing information. By doing so, it is much more likely that the customer who receives the customized communication will read the non-billing information while reading the bill. The effectiveness of the non-billing information is greatly increased by placing it between the initial customer greeting and the billing amount placed at the end of the bill, than it would be if placed around the periphery of the bill.

According to one embodiment of the invention, a system employs a computer database and a set of classifications that are correlated to customer traits. The classifications are assigned to customers, and recorded with the customer profiles in the database. Non-billing information is classified according to the same set of classifications to form non-billing information profiles, which are also stored in the database. The database also contains billing information for the customers. The billing information for a customer is combined with any non-billing information that has a classification matching a classification assigned to the customer. This combined billing information and targeted non-billing information is conveyed to the customer as a customized communication.

### **Summary of the Cited Reference**

*Remington* describes an electronic bill presentment and payment system. The system is configured for use over the Internet. According to this system, a biller may create an electronic

bill and forward it electronically over the Internet to a consumer. The consumer may challenge portions of the bill according to predefined dispute reasons and may authorize partial or full payment. The remittance is transmitted electronically back over the Internet to the biller where payment instructions are then forwarded by the biller from the consumer to the biller's bank. Although *Remington* describes optional inclusion of third-party advertising, the advertising is placed along a banner strip across the top or bottom of the bill.

*Dedrick* provides a method and apparatus for sending electronic advertising to end users in a consumer best-fit pricing manner. *Dedrick* describes comparing characteristics of end users served by a particular metering server with a consumer scale associated with the electronic advertisement. The higher the characteristics of the end users fall on the scale, the higher the fee charged to the advertiser. As will be discussed below, *Dedrick* does not suggest combining billing information with the advertising described by *Dedrick*.

#### Record of Telephone Interview

The applicants would like to thank the Examiners for an interview that took place on June 15, 2004 between Leonard Hope, Mike Baldauff, Examiner James Kramer, and Primary Examiner Mike Cuff. During the interview, the participants discussed the appropriateness of the finality of the Office Action. The finality was maintained following the interview.

#### Independent Claim 1

Claim 1 was rejected under 35 U.S.C. § 103(a) as being obvious over *Remington* in view of *Dedrick*. The applicants have amended independent claim 1 to more clearly reflect aspects of the present invention. The applicants submit that *Remington* in combination with *Dedrick* fails to teach, suggest, or describe each recitation of amended claim 1. In particular, *Remington* in combination with *Dedrick* fails to describe "wherein combining the billing information and the non-billing information comprises positioning the non-billing information within said customized communication between a customer identifier located at the beginning of the communication and a billing amount located at the end of the communication" as recited by claim 1.

*Remington* describes the optional placing of advertising on a banner strip around the perimeter of the electronic bill. *Remington* states in column 10, lines 29-31, “[t]he banner strip may also be partitioned to allow re-use of parts of the bill interface for third party advertising purposes.” FIGS. 7-9 of *Remington* show advertisements placed on the outer perimeter of the bill, with the billing information in the center. The applicants submit that placing advertisements around the outer edges of a bill is not equivalent to “positioning the non-billing information within said customized communication between a customer identifier located at the beginning of the communication and a billing amount located at the end of the communication” as recited by claim 1. The placement of non-billing information on a bill may have a significant impact on the ability to convey that information effectively.

The applicants respectively submit that it would not be obvious to modify *Remington* to include advertising or other non-billing information within the electronic bill taught by *Remington* so that the non-billing information appears between the customer identifier and the billing amount. By describing and illustrating a main body portion of an electronic bill where the billing particulars are included and a banner strip along the outer perimeter of the bill for advertising purposes, *Remington* teaches away from the placement of non-billing information in a position within the billing information as recited by amended independent claim 1.

*Dedrick* also fails to describe “positioning the non-billing information within said customized communication between a customer identifier located at the beginning of the communication and a billing amount located at the end of the communication” as recited by claim 1. *Dedrick* describes comparing characteristics of end users served by a particular metering server with a consumer scale associated with the electronic advertisement. This comparison is made in order to determine the fee to be charged to the advertiser. *Dedrick* describes a billing process, for both consumers and advertisers. The billing method described by *Dedrick* does not include any non-billing information. Because *Dedrick* describes both advertising based upon customer characteristics and billing customers as separate processes, *Dedrick* teaches away from including advertisements or other non-billing information in customer bills. For at least these reasons, the applicants submit that independent claim 1 is allowable over *Remington* in view of *Dedrick*.

Independent Claim 10

Claim 10 was rejected under 35 U.S.C. § 103(a) as being obvious over *Remington* in view of *Dedrick*. The applicants have amended independent claim 10 to more clearly reflect aspects of the present invention. The applicants submit that *Remington* in combination with *Dedrick* fails to teach, suggest, or describe each recitation of amended claim 10. In particular, *Remington* in combination with *Dedrick* fails to describe “wherein the non-billing information is located at a position within said customized communication that is between a customer identifier located at the beginning of the communication and a billing amount located at the end of the communication” as recited by claim 10. As discussed above with respect to independent claim 1, neither *Remington* nor *Dedrick*, alone or in combination, teach, suggest or describe this recitation. For at least the reasons discussed with respect to claim 1, independent claim 10 is allowable over *Remington* in view of *Dedrick*.

Dependent Claims 7 and 18

The applicants respectfully submit that the cited art fails to teach a customized communication that comprises a newsletter as recited by claims 7 and 18. The Examiner noted in the May 28, 2004 Office Action that “*Remington et al.* does not teach sending the customized communication through regular mail channels as a newsletter. Examiner notes that the Official Notice taken in the Office Action mailed 12/3/03 is now admitted prior art. Specifically, it is old and well known in the art for billers to send bills to user through the mail, in order to reach customers that do not have computer access.” The applicants would like to clarify that the Official Notice was directed to “it is old and well known in the art for billers to send bills to user through the mail,” and not related to the recitations of dependent claims 7 and 18, which state “wherein said customized communication comprises a newsletter.” The applicants submit that neither *Remington* nor *Dedrick* describe a customized communication comprising a newsletter. For at least this reason, and because claims 7 and 18 depend from allowable independent claims 1 and 10, dependent claims 7 and 18 are allowable over *Remington* in view of *Dedrick*.

Dependent Claims 4, 7-9, 11-13, 15, and 18-20

Because *Remington* in combination with *Dedrick* fails to teach, suggest, or describe the recitations of claims 4, 7-9, 11-13, 15, and 18-20 and because claims 4, 7-9, 11-13, 15, and 18-20 depend from allowable independent claims 1 and 10, dependent claims 4, 7-9, 11-13, 15, and 18-20 are allowable over *Remington* in view of *Dedrick*.

New Claims 21, 23, and 24

Because the cited art fails to teach, suggest, or describe the recitations of new claims 21, 23, and 24 and because claims 21, 23, and 24 depend from allowable independent claims 1 and 10, new claims 21, 23, and 24 are allowable over the prior art of record.

New Claim 22

The applicants submit that the cited art fails to teach, suggest, or describe the recitations of new claim 22. The cited art does not describe a database comprising 3 tables, the first being a customer table, the second being a billing information table, and the third being a non-billing information table as recited by claim 22. *Dedrick* describes comparing customer characteristics to a consumer scale that is created by the advertiser to assign value to characteristics for each advertisement. *Dedrick* does not describe doing this using three tables, each with the specific contents recited by claim 22. For at least this reason, and because claim 21 depends from allowable independent claim 1, new claim 21 is allowable over the prior art of record.

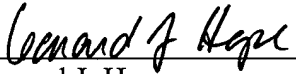
**Conclusion**

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the applicants' attorney at the number listed below.

Respectfully submitted,

MERCHANT & GOULD

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